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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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27799 7590 09/12/2008 COHEN, PONTANI, LIEBERMAN & PAVANE LLP 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176				
EXAMINER MOORTHY, ARAVIND K				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/580,970

**Applicant(s)**

UEDA ET AL.

**Examiner**

Aravind K. Moorthy

**Art Unit**

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 30 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date see attachment  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This is in response to the communications filed on 30 May 2006.
2. Claims 1-17 are pending in the application.
3. Claims 1-17 have been rejected.

***Information Disclosure Statement***

4. The examiner has considered the information disclosure statement (IDS) filed on 30 May 2006.

***Specification***

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims –17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the utilization license information," "the download," and "the music data" in the claim. There is insufficient antecedent basis for these limitations in the claim.

Claim 2 recites the limitation "the computer," "the utilization license information," "the recording medium," "the music data," "the specific server," "the server" and "the download" in the claim. There is insufficient antecedent basis for these limitations in the claim.

Claim 3 recites the limitation "the image data" in the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the computer," "the utilization license information," "the recording medium," "the streaming," "the music data," "the specific server," "the server" and "the data" in the claim. There is insufficient antecedent basis for these limitations in the claim.

Claim 7 recites the limitation "the history information," "the streamed music data," and "the streaming" in the claim. There is insufficient antecedent basis for these limitations in the claim.

Claim 9 recites the limitation "the control program," "the computer," "the utilization license information," "the download," "the specific music data," and "the transmission" in the claim. There is insufficient antecedent basis for these limitations in the claim.

Claim 10 recites the limitation "the utilization license information," "the recording medium," "the download," "the music data," "the specific server" and "the server" in the claim. There is insufficient antecedent basis for these limitations in the claim.

Claim 11 recites the limitation "the inputted image data" in the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "the music data" in the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the information recording apparatus," "the utilization license information," "the recording medium," "the streaming," "the music data," "the specific server," "the server" and "the reproduction means" in the claim. There is insufficient antecedent basis for these limitations in the claim.

Claim 15 recites the limitation "the history information" and "the streamed music data" in the claim. There is insufficient antecedent basis for these limitations in the claim.

Claim 16 recites the limitation "the streamed music data," "the inputted image data," and "the reproduction means" in the claim. There is insufficient antecedent basis for these limitations in the claim.

Any claims not directly addressed are rejected on the virtue of their dependency.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 5-11 and 13-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Hiratsuka US 2004/0064380 A1.

As to claim 1, Hiratsuka discloses a recording medium (i.e. recording medium RMb) [0022] in which the utilization license information (i.e. a predetermined initial value (for example, "2") is set in the copy control data Dc at the downloading time, and this initial value restricts the number of times the music data downloaded by the relevant user can be copied. Further, each time the relevant music data are copied (sent, recorded) from the personal computer PC into the electronic musical instrument KD or recording medium RM, the contents of the copy control data Dc are decremented and indicate the current value of the number of times the relevant music data can be copied. Here, the initial value of the copy control data Dc

(copy restriction times) may be set so as to be changed music by music by storing a different data value for each music.) [0033] showing that the download [0033] or streaming of the music data stored in a specific server (i.e. server SV) [0017] is permitted is recorded (i.e. By making reference to the contents of the copy control data from the server SV, the terminal PC determines whether or not to permit sending of the relevant music data Dmd to the electronic musical instrument KD and, if the contents of the copy control data are "1" or more, the terminal PC determines as "Yes" (P10-1) and executes sending of the relevant music data Dmd (P10-2). Further, if the contents of the copy control data Dc are "0" (zero) (the decrement of the data Dc by "1" executed by the server SV each time the request for copying is sent is carried out until the data Dc become "0"), the terminal PC determines as "No" (P10-1) and lets the display 6 of the terminal PC display a message that "the music data cannot be sent because the music data are already copied" without sending the relevant music data to the electronic musical instrument KD (P10-3). Then, the electronic musical instrument KD that has received the music data stores the received music data into the storing device, keeping the music data still encoded under the condition of "Yes" determination (K2-1 and K2-2).) [0057].

As to claim 2, Hiratsuka discloses a control program for functioning the computer (i.e. Personal computer) [0016] as a means for reading the utilization license information (i.e. a predetermined initial value (for example, "2") is set in the copy control data Dc at the downloading time, and this initial value restricts the number of times the music data downloaded by the relevant user can be copied. Further, each time the relevant music data are copied (sent, recorded) from the personal computer PC into the electronic musical instrument KD or recording medium RM, the contents of the copy control data Dc are decremented and indicate the current

value of the number of times the relevant music data can be copied. Here, the initial value of the copy control data Dc (copy restriction times) may be set so as to be changed music by music by storing a different data value for each music.) [0033] recorded in the recording medium (i.e. recording medium RMb) [0022], and for identifying whether the recording medium is a recording medium for which the download [0033] of the music data stored in the specific server (i.e. server SV) [0017] is permitted, and when the recording medium is a permitted recording medium, as a means for requiring to the server the download of the music data (i.e. By making reference to the contents of the copy control data from the server SV, the terminal PC determines whether or not to permit sending of the relevant music data Dmd to the electronic musical instrument KD and, if the contents of the copy control data are "1" or more, the terminal PC determines as "Yes" (P10-1) and executes sending of the relevant music data Dmd (P10-2). Further, if the contents of the copy control data Dc are "0" (zero) (the decrement of the data Dc by "1" executed by the server SV each time the request for copying is sent is carried out until the data Dc become "0"), the terminal PC determines as "No" (P10-1) and lets the display 6 of the terminal PC display a message that "the music data cannot be sent because the music data are already copied" without sending the relevant music data to the electronic musical instrument KD (P10-3). Then, the electronic musical instrument KD that has received the music data stores the received music data into the storing device, keeping the music data still encoded under the condition of "Yes" determination (K2-1 and K2-2.) [0057].

As to claims 3, 11 and 16, Hiratsuka discloses that it further functions the computer as a means for inputting the image data, a means for making a predetermined format of moving image data based on the downloaded music data and the image data, and a means for recording at

least one of the music data, the image data and the moving image data in the recording medium (i.e. the music information Dm is made of a music reference number (music ID number) for specifying the relevant music data, an SMF (Standard MIDI File) representing the contents of the relevant music as well as lyric data, image data, and other data corresponding to the relevant music, as illustrated in the central two columns of FIG. 2. Here, the other data of each of the music data include the copy control data Dc representing the number of times the relevant music data can be copied, as shown by broken lines in the rightmost column. However, the copy control data Dc need not be stored for each of the music data if the same number (for example "2" (at the time of downloading)) is to be set, irrespective of the music, in the copy control data Dc.) [0034].

As to claims 5, 8, 13 and 17, Hiratsuka discloses that it further functions the computer as a means for selecting the music data to be downloaded or streamed from among the music data recorded in the server (i.e. the server SV sends a list of music data that can be purchased (S2). As a result, the list of music data is displayed on the display 6 of the terminal PC. When the user indicates a desired music by selection from this list of music data using an operator 5, the music reference number (music ID number) of the music data corresponding to the relevant music is sent to the server SV (P3).) [0048].

As to claim 6, Hiratsuka discloses the control program for functioning the computer as the means for reading the utilization license information (i.e. a predetermined initial value (for example, "2") is set in the copy control data Dc at the downloading time, and this initial value restricts the number of times the music data downloaded by the relevant user can be copied. Further, each time the relevant music data are copied (sent, recorded) from the personal



computer PC into the electronic musical instrument KD or recording medium RM, the contents of the copy control data Dc are decremented and indicate the current value of the number of times the relevant music data can be copied. Here, the initial value of the copy control data Dc (copy restriction times) may be set so as to be changed music by music by storing a different data value for each music.) [0033] recorded in the recording medium (i.e. recording medium RMb) [0022], and for identifying whether the recording medium is a recording medium for which the streaming of the music data stored in the specific server (i.e. server SV) [0017] is permitted, and when the recording medium is a permitted recording medium, as a means for requiring to the server the streaming of the data (i.e. By making reference to the contents of the copy control data from the server SV, the terminal PC determines whether or not to permit sending of the relevant music data Dmd to the electronic musical instrument KD and, if the contents of the copy control data are "1" or more, the terminal PC determines as "Yes" (P10-1) and executes sending of the relevant music data Dmd (P10-2). Further, if the contents of the copy control data Dc are "0" (zero) (the decrement of the data Dc by "1" executed by the server SV each time the request for copying is sent is carried out until the data Dc become "0"), the terminal PC determines as "No" (P10-1) and lets the display 6 of the terminal PC display a message that "the music data cannot be sent because the music data are already copied" without sending the relevant music data to the electronic musical instrument KD (P10-3). Then, the electronic musical instrument KD that has received the music data stores the received music data into the storing device, keeping the music data still encoded under the condition of "Yes" determination (K2-1 and K2-2).) [0057].

As to claims 7 and 15, Hiratsuka discloses that it further functions the computer as a means for storing the history information for specifying the streamed music data, and as a means

for permitting the streaming to the music data specified by the history data (i.e. a list of the music data already purchased by the relevant user to the personal computer terminal PC that has requested for the resupplying of the music data by making reference to the music data purchase information Db of the user information area Du of the relevant user in the storing device (HD) (S6.)) [0052].

As to claim 9, Hiratsuka discloses the control program for functioning the computer as the means for receiving the utilization license information (i.e. a predetermined initial value (for example, "2") is set in the copy control data Dc at the downloading time, and this initial value restricts the number of times the music data downloaded by the relevant user can be copied. Further, each time the relevant music data are copied (sent, recorded) from the personal computer PC into the electronic musical instrument KD or recording medium RM, the contents of the copy control data Dc are decremented and indicate the current value of the number of times the relevant music data can be copied. Here, the initial value of the copy control data Dc (copy restriction times) may be set so as to be changed music by music by storing a different data value for each music.) [0033] showing that the download [0033] or streaming of the specific music data stored in a specific server (i.e. server SV) [0017] is permitted, and as a means for connecting the specific server to the transmission original location of the utilization license information so that the download or streaming of the specific music data can be performed (i.e. By making reference to the contents of the copy control data from the server SV, the terminal PC determines whether or not to permit sending of the relevant music data Dmd to the electronic musical instrument KD and, if the contents of the copy control data are "1" or more, the terminal PC determines as "Yes" (P10-1) and executes sending of the relevant music data Dmd (P10-2).

Further, if the contents of the copy control data Dc are "0" (zero) (the decrement of the data Dc by "1" executed by the server SV each time the request for copying is sent is carried out until the data Dc become "0"), the terminal PC determines as "No" (P10-1) and lets the display 6 of the terminal PC display a message that "the music data cannot be sent because the music data are already copied" without sending the relevant music data to the electronic musical instrument KD (P10-3). Then, the electronic musical instrument KD that has received the music data stores the received music data into the storing device, keeping the music data still encoded under the condition of "Yes" determination (K2-1 and K2-2.) [0057].

As to claim 10, Hiratsuka discloses an information recording apparatus is at least provided with a means for reading the utilization license information (i.e. a predetermined initial value (for example, "2") is set in the copy control data Dc at the downloading time, and this initial value restricts the number of times the music data downloaded by the relevant user can be copied. Further, each time the relevant music data are copied (sent, recorded) from the personal computer PC into the electronic musical instrument KD or recording medium RM, the contents of the copy control data Dc are decremented and indicate the current value of the number of times the relevant music data can be copied. Here, the initial value of the copy control data Dc (copy restriction times) may be set so as to be changed music by music by storing a different data value for each music.) [0033] recorded in the recording medium (i.e. recording medium Rmb) [0022], and for identifying whether the recording medium is a recording medium for which the download [0033] of the music data stored in the specific server (i.e. server SV) [0017] is permitted, and when the recording medium is a permitted recording medium, a means for requiring to the server the download of the music data, and a means for recording the

downloaded music data in the recording medium (i.e. By making reference to the contents of the copy control data from the server SV, the terminal PC determines whether or not to permit sending of the relevant music data Dmd to the electronic musical instrument KD and, if the contents of the copy control data are "1" or more, the terminal PC determines as "Yes" (P10-1) and executes sending of the relevant music data Dmd (P10-2). Further, if the contents of the copy control data Dc are "0" (zero) (the decrement of the data Dc by "1" executed by the server SV each time the request for copying is sent is carried out until the data Dc become "0"), the terminal PC determines as "No" (P10-1) and lets the display 6 of the terminal PC display a message that "the music data cannot be sent because the music data are already copied" without sending the relevant music data to the electronic musical instrument KD (P10-3). Then, the electronic musical instrument KD that has received the music data stores the received music data into the storing device, keeping the music data still encoded under the condition of "Yes" determination (K2-1 and K2-2).) [0057].

As to claim 14, Hiratsuka discloses the information recording apparatus is at least provided with a means for reading the utilization license information (i.e. a predetermined initial value (for example, "2") is set in the copy control data Dc at the downloading time, and this initial value restricts the number of times the music data downloaded by the relevant user can be copied. Further, each time the relevant music data are copied (sent, recorded) from the personal computer PC into the electronic musical instrument KD or recording medium RM, the contents of the copy control data Dc are decremented and indicate the current value of the number of times the relevant music data can be copied. Here, the initial value of the copy control data Dc (copy restriction times) may be set so as to be changed music by music by storing a different data

value for each music.) [0033] recorded in the recording medium (i.e. recording medium Rmb) [0022], and for identifying whether the recording medium is a recording medium for which the streaming [0033] of the music data stored in the specific server (i.e. server SV) [0017] is permitted, and when the recording medium is a permitted recording medium, a means for requiring the streaming of the music data to the server, and a means for reproducing the music data transmitted from the server in the reproduction means (i.e. By making reference to the contents of the copy control data from the server SV, the terminal PC determines whether or not to permit sending of the relevant music data Dmd to the electronic musical instrument KD and, if the contents of the copy control data are "1" or more, the terminal PC determines as "Yes" (P10-1) and executes sending of the relevant music data Dmd (P10-2). Further, if the contents of the copy control data Dc are "0" (zero) (the decrement of the data Dc by "1" executed by the server SV each time the request for copying is sent is carried out until the data Dc become "0"), the terminal PC determines as "No" (P10-1) and lets the display 6 of the terminal PC display a message that "the music data cannot be sent because the music data are already copied" without sending the relevant music data to the electronic musical instrument KD (P10-3). Then, the electronic musical instrument KD that has received the music data stores the received music data into the storing device, keeping the music data still encoded under the condition of "Yes" determination (K2-1 and K2-2).) [0057].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiratsuka US 2004/0064380 A1 as applied to claims 2 and 10 above, and further in view of Moon US 2002/0076209 A1.

As to claims 4 and 12, Hiratsuka teaches reproducing music data [0021]

Hiratsuka does not teach that the recording means records a dummy data for operating a specific program which reproduces the music data.

Moon teaches that when a user desires to record secondary audio later, the secondary audio is recorded on a corresponding portion of the second audio in a dummy state. When the second audio is overwritten by the secondary audio in this way, it is recognized by the user for the first time, and the user selects and reproduces one audio among the first audio and the second audio. Since the second audio is the same as the first audio except for the portion on which the secondary audio is recorded, the same content is reproduced even if the selection of audio is changed. The reason why second audio having the same content as the content of first audio is recorded is that in the case of a digital recording medium, it is difficult to extract and reproduce portions on which secondary audio has been recorded. That is, if the second audio is reserved and only part thereof is occupied by secondary audio, audio is not reproduced from portions on

which secondary audio has not been recorded, when the second audio is selected, which causes a user to be confused [0065].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Hiratsuka so that there would have been secondary audio recorded in a dummy state which would have been used for a program that reproduces the music data.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Hiratsuka by the teaching of Moon because it makes it difficult to extract and reproduce portions on which secondary audio has been recorded. That is, if the second audio is reserved and only part thereof is occupied by secondary audio, audio is not reproduced from portions on which secondary audio has not been recorded, when the second audio is selected, which causes a user to be confused [0065].

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aravind K Moorthy/  
Examiner, Art Unit 2131  
/Ayaz R. Sheikh/  
Supervisory Patent Examiner, Art Unit 2131